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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,963	12/15/2003	Jan Lindy Sorensen	6567.200-US	3391

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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,963

Applicant(s)

SORENSEN ET AL.

Examiner

Celia Chang

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-67 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-67 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-18, and claims 1-16, 19-52, 64 in part, drawn to compounds and composition wherein Y is a 5 membered monocyclic heteroaryl, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound is also required. Further restriction based on the species with respect to r i.e. pyrrolidine, piperidine or azepidine will be required.
- II. Claims 14-16 excluding monocyclic of group I, and claims 1-13, 19-52, 64, in part drawn to compounds and composition wherein Y is 50membered multiple ring heteroaryl, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound is also required. Further restriction based on the species with respect to r i.e. pyrrolidine, piperidine or azepidine will be required.
- III. Claim 13 excluding 5-membered heteroaryl, and claims 1-12, 19-52, 64 in part drawn to compounds and composition wherein Y is 6-membered ring heteroaryl, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound is also required. Further restriction based on the species with respect to r i.e. pyrrolidine, piperidine or azepidine will be required.

- IV. Claims 1-12, 19-52, 64 excluding the above groups I-III drawn to compounds and composition wherein Y is the remaining moieties, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound is also required. Further restriction based on the species with respect to r i.e. pyrrolidine, piperidine or azepidine will be required.
- V. Claims 53, 63, 67, drawn to method of inhibiting histamine H3 receptor, classified in class 514, subclass various, depending on species election. If this group is elected a further election of a single disclosed compound for treating a single histamine H3 receptor pathology is also required. Further restriction with respect to compounds and diseases may be required.
- VI. Claims 54-55, drawn to method of reducing body weight, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclose compound for the method is also required. Further restriction may be required.
- VII. Claim 56, drawn to method of suppressing appetite, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclose compound for the method is also required. Further restriction may be required.
- VIII. Claim 57, drawn to method of treating disorder/disease related to overweight, classified in class 514, subclass various, depending on species election. If this

group is elected, a further election of a single disclose compound for a single related disorder is also required. Further restriction may be required.

- IX. Claim 58, drawn to method of treating eating disorder, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclose compound and a single disclosed eating disorder is also required. Further restriction may be required.
- X. Claims 59-61, drawn to method of treating IGT/type II diabetes, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclose compound for the method is also required. Further restriction may be required.
- XI. Claim 65, drawn to method of treating allergy, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclose compound for a single disclosed allergy is also required. Further restriction may be required.
- XII. Claim 66, drawn to method of treating Alzheimer's disease, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclose compound for the method is also required. Further restriction may be required.

The inventions are distinct, each from the other because:

Compounds of groups I-IV are independent and distinct because the structure of core for the compounds differ in elements, bonding arrangements and chemical properties to such an extent that they do not share substantial structural similarity as to be considered as a single class

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of compounds. A reference anticipating any one group compounds would not render the other groups obvious.

Inventions I-IV and V-XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of treating Alzheimer's disease can be practice with Tacrine (see US 5,397,785).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Advisory of a Rejoinder

The following is a recitation of MPEP 821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered. *Applicants are reminded of propriety of process of use claims in consideration of the "reach-trough" format which is drawn to mechanistic, receptor binding or enzymatic functionality. Reach*

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through claims are considered lacking of descriptive and enabling support from the specification. Thus, rejoinable process of use claims are those with particular disease named with efficacy support from the specification for treating the particular disease.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either: (A) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and

examined under 37 CFR 1.129(b)(2); or (B) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that "[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a

fee...will not entitle a party to a refund of such fee..." In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

The following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. 103(b)" (1184 TMOG 86(March 26, 1996)):

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim **depends from or otherwise includes all of the limitations** of an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined." (emphasis added)

Therefore, in accordance with MPEP 821.04 and *In re Ochiai*, 71 F. 3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Should applicant traverse on the ground that the groups and/or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups and/or species to be obvious variants or clearly admit on the record that this is the case.

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In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, then there could have been no patentability of all the claims over Ohki et al. CA 129:54604 see RN 208538-08-3 anticipated claim 1 when R1 is alkyl, r=1, s=0, X is bond, Y is heteroaryl, R4 is aryl substituted with acyl.

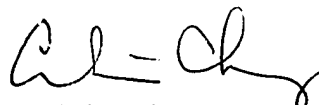
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Jan. 25, 2006



Celia Chang
Primary Examiner
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